

Serial No.: 10/735,208

PATENT APPLICATION
Docket No.: NC 84,693

REMARKS

Claims 1-6 and 8-32 are pending in the application. Claims 2-5, 8-13, and 31 have been withdrawn pursuant to a restriction/election of species requirements. Claim 14 was found to be allowable if in independent form.

Claim 1 has been amended to add a missing "and."

No new matter has been added.

Claim Rejections – 35 U.S.C. § 112

Claims 1, 6, 14-18, 22, 23, 27-30, and 32 have been rejected under 35 U.S.C. § 112, first paragraph as being allegedly nonenabled. The Examiner stated that the specification is enabling for a process of making a conductive coating, but not for any coating.

The coating recited in claim 1 (claims 6, 14-18, 27-30, and 32 dependent thereon) is a mixture of a solvent, a monomer, an oxidizing agent, and a moderator. The recited coating is not the final product of the process. Nowhere in the specification is it stated that this coating is conductive. Thus, there is no basis for the statement that the specification is enabling of only conductive coatings.

The specification provides enablement for forming this coating, regardless of any electrical properties of the coating, in paragraph 0047, which shows an example that the coating may be made by spin-coating.

The Examiner stated that the claimed invention relates to highly conducting and transparent films. This appears to be a quotation from paragraph 0001. However, the complete sentence states that the "invention relates to the formation of polymer films, including highly conducting and transparent thin polymer films." The specification is not limited to highly conducting and transparent films, and further, the polymer films are not the recited coating.

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph as being allegedly indefinite. Specifically, that there should an "and" after "120°C." The "and" has been added by this amendment.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 22, 24-27, 29, and 30 have been rejected under 35 U.S.C. § 102(b) as allegedly

Serial No.: 10/735,208

PATENT APPLICATION
Docket No.: NC 84,693

anticipated by Angelopoulos et al. (US 6,153,725).

In order to make a *prima facie* case of anticipation, the reference must disclose each limitation of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP 2131. Among other deficiencies, the reference does not disclose the limitation in claim 1 that a moderator is in the coating.

The moderator forms a complex with the oxidizing agent, thus lowering the oxidative capacity of the agent (0021, lines 10-12). No such moderator is disclosed in Angelopoulos. The Examiner stated that the solvent, including pyridine or DMF, would act as the moderator. However, the solvent only acts to dissolve the polymer (col. 7, lines 7-9) and does not form a complex with the oxidizing agent. It is also noted that the claim requires both a solvent and a moderator, not one compound that is both. As all the claim limitations are not disclosed in the reference, a *prima facie* case of obviousness has not been made.

Claims 22, 24-27, 29, and 30 depend from and contain all the limitations of claim 1. The arguments regarding the lack of *prima facie* for claim 1 are applicable to claims 22, 24-27, 29, and 30.

Claim Rejections – 35 U.S.C. § 103

Claims 6, 15-21, and 32 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Angelopoulos.

As claims 6, 15-21, and 32 are dependent on claim 1, the arguments above regarding claim 1 apply.

Claim 28 has been rejected under 35 U.S.C. § 102(a) as allegedly unpatentable over Angelopoulos in view of de Leeuw et al. (*Synth. Met.*, 66, pp. 263-273).

As claim 28 is dependent on claim 1, the arguments above regarding claim 1 apply.

Claim 23 has been rejected under 35 U.S.C. § 102(a) as allegedly unpatentable over Angelopoulos in view of Smith et al. (US 5,968,416).

As claim 23 is dependent on claim 1, the arguments above regarding claim 1 apply.

Serial No.: 10/735,208

PATENT APPLICATION
Docket No.: NC 84,693

In view of the foregoing, it is submitted that the application is now in condition for allowance.

In the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



Joseph T. Grunkemeyer
Reg. No. 46,746
Phone No. 202-404-1556
Office of the Associate Counsel
(Patents), Code 1008.2
Naval Research Laboratory
4555 Overlook Ave, SW
Washington, DC 20375-5325